

RECEIVED

AUG 21 2001

Application No.: 09/270,710
Art Unit: 2166

Technology Center 2100

Attorney Docket No.: 740388-0020
Page 2

REMARKS

At the outset, the Examiner is thanked for the review and consideration of the present application.

The Examiner's Office Action dated February 13, 2001 has been received and its contents reviewed. Claims 1-21 were pending in the present application. By this amendment, new claim 22 has been added. Accordingly, claims 1-22 are pending, of which claims 1 and 20 are independent.

Referring now to the Office Action, claims 1-21 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Goldschmitt et al. (WO 96/24213A1, herein after Goldschmitt) in view of "World Wide Watch" (herein after The Mail). This rejection is respectfully traversed at least for the reasons provided below.

The present invention addresses the effectiveness issue of known methods of advertisement, such as internet banners, unsolicited commercial e-mail, etc. (as described in page 1, second paragraph to page 4, first paragraph of the present application) and provides a method for a party sending a telecommunication message to include an advertisement in the message and send the same to a recipient so as to effect a point-to-point advertisement method. More specifically, in one exemplary embodiment, the presently claimed invention is directed to a method for sending an email communication from a sending party to a receiving party, wherein the email includes an advertisement for a product or service used by the sending party. The product could be a software or hardware installed and operated on a computer system used by the sending party, and the inclusion of the product advertisement with the email resulted from an election made by the sending party during the installation of the software/hardware module. In a further embodiment of the invention, the advertisement further includes a testimonial by the sending party regarding the product or service used by the sending party so as to lend credibility to the advertisement.

Through the use of Applicant's invention, a grass root level of advertisement is effected by which an email sender has the power to select the product or service that he/she wishes to endorse and his/her testimonial provided with an email message further strengthen the endorsement. Moreover, as the sending party has control of whether to become an advertiser or not, selected advertisements transmitted to email recipients known by the sending party via the method of the presently claimed invention are not considered as spams.

On the other hand, Goldschmitt's invention relates to a method for providing free email messaging to end-users, wherein the free email messaging is supported by sponsors who advertise their products and services by appending an advertisement to an email message after a special delimitator. In the operation of an aspect of Goldschmitt's invention, an email message sent by a sender is received and stored at a remote mail server associated with advertisement sponsors. Upon request by an addressee to download a message, an advertisement is selected and appended to the email message after a special delimitator, then the email and the appended advertisement is sent to the addressee (see page 3, lines 18-28 of Goldschmitt).

The method of delivery of an advertisement in the system for providing free email service of Goldschmitt is specifically designed for providing, among other things, specific advertisement at specific targeted time of the day. Therefore, an advertisement is appended to an incoming email as the email is downloaded by the addressee from the email server (see page 4, line 26 to page 5, line 19 of Goldschmitt). Moreover, the appending of an advertisement to an email is performed at a remote mail server associated with the sponsors.

In the invention of Goldschmitt, subscribers of free email are provided with no choice but to have email advertisement appended to their messages. Further, subscribers of free email messaging have no control over the products or services that are advertised by the sponsors. As such, spamming would be considered as an effect of utilizing Goldschmitt's invention.

Turning now to the claims, in addition to being deficient in disclosing or suggesting embedding an advertisement with a communication, as acknowledged by the Examiner, Applicant respectfully submits that Goldschmitt also is deficient in the steps of associating a preselected advertisement with a communication within the data processing system associated with the sending party and transmitting said communication with said preselected advertisement embedded therein to the recipient as set forth in amended independent claim 1. Rather, as disclosed in Fig. 1, page 8, line 26 - page 9, line 2, Goldschmitt teaches that a message sent by user 12 to user 20 and is stored at center 18 until user 20 accesses it. When user 20 commands to read the message, the center 18 then appends an advertisement, if any, to the message and transmits the message to user 20.

Support for the amendment of claim 1 can be found in at least page 14, last paragraph, Fig. 1, and page 17, 1 paragraph of the specification

With respect to claim 2, further to not disclosing or suggesting the features recited in claim 1, Applicant respectfully submits that Goldschmitt does not disclose or suggest the steps of offering the sender an option to become an advertiser and enabling, if the offer is accepted, a procedure within [emphasis added] the data processing system by which the preselected advertisement is associated with the communication.

The Examiner contended that by offering free email Goldsmith provides a sender an option to become an advertiser. However, Goldschmitt offers free email messaging with no opportunity for a user of free email messaging to select whether he/she can opt out of having advertisements appended to his/her email messages. In contrast to the invention of Goldschmitt, as recited in claim 2, if the offering to become an advertiser is not accepted, no advertisement would be associated with an email. Therefore, if sender chooses not to become an advertiser, he/she can still send an email.

Moreover, Goldschmitt teaches that an advertisement is appended to an email at a center 18 where email server is located and not within the data processing system associated with the sending party, as recited in claim 2.

With respect to claim 3, Goldschmitt does not teach or suggest the feature wherein the advertisement is associated with at least one of software or hardware operable with the data processing system. The abstract of the Goldschmitt reference merely states that information related to a particular subscriber communication network, which is a part of the email server communication network associated with the sponsors, could be shown in an advertisement. However, there is no suggestion of the software or hardware operable with the data processing system associated with the sending party as recited in claim 3.

With respect to claims 4, 5, 6, 9, 15, 16, 18, and 19, Applicant's argument in relation to independent claim 1 is also applicable to the rejection of dependent claims 4, 5, 6, 9, 15, 16, 18, and 19.

With respect to claims 7 and 14, Applicant respectfully submit that Goldschmitt does not teach electronically obtaining a preselected advertisement and associating the preselected advertisement with the communication within the data processing system associated with the sending party as recited in amended claim 7 and claim 14. As disclosed by Goldschmitt, the system for providing free email messaging utilizes center 18 and the servers therein to intercept and append an advertisement to an email when a recipient initiates the downloading of the email message. The advertisements to be appended to email messages are stored

within center 18, as shown if Fig. 1 of Goldschmitt. The invention of Goldschmitt is therefore different than Applicant's invention recited in claims 7 and 14.

With respect to claims 8, 10, 11, 12, 13, and 17, Applicant's argument in relation to claims 1 and 2 also are applicable to claims 8, 10, 11, 12, 13, and 17.

With respect to independent claim 20, the Examiner conceded that Goldschmitt does not disclose locating a data file containing signature information on the data processing system associated with the sending party, the signature information being appended to electronic communications originating from the data processing system associated with the sending party, modifying information stored within the signature file to include an advertisement, and transmitting an electronic communication using the data processing system associated with the sending party to the data processing system associated with a recipient, wherein the electronic communication includes the information stored within the signature file and the advertisement.

Applicant appreciates the Examiner's acknowledgment of the deficiencies of Goldschmitt and respectfully submits that Goldschmitt specifically teaches that advertisements are appended to an email message after a special delimitator, and a delimiter is positioned between an email message and an advertisement. Further, Applicant respectfully submits that Goldschmitt does not teach, disclose, or suggest modifying the information stored in the signature file to include an advertisement.

It is acknowledged that signature block is well known and incorporating hypertext links and graphics is also well known. However, Applicant respectfully submit that modifying the signature block so as to include advertisement information is not known, as shown by the lack of disclosure or suggestion of such a feature in the cited prior art.

Further, Applicant respectfully submits that graphics and hypertext links found in signature blocks are customarily added to a signature block one time during the creation of a signature block, and that the signature block is customarily not modified as an email message is being processed for transmission. Moreover, it would not be possible for the remotely located message center 18, wherein the appending of an advertisement to an email message is performed, to have access to the sending party's signature file to modify it in the manner recited in claim 20.

Applicant respectfully submit that the Examiner's contention that it is obvious to modify the signature block to include advertisement information based on the known

existence of hypertext links and graphics in a signature block is purely a hind sight and is insupportable.

With respect to claim 21, as discussed above, the signature file is associated with a email client operating on the data processing system associated with the sending party. Therefore, it would not be possible for the free email system of Goldschmitt to have access and to manipulate the information in the signature file of the sending party as contended by the Examiner.

In view of the amendment and arguments set forth above, Applicant respectfully request reconsideration and withdrawal of the § 103 rejection of claims 1-21.

New claim 22 has been added to further complete the scope of the invention to which Applicant is entitled. Support for new claim 22 can be found at least in, e.g., page 15, lines 9-15 of the specification. Applicant respectfully submit that Goldschmitt does not teach, disclose, or suggest associating a personal testimonial by said sending party.


CONCLUSION

Having responded to all rejections set forth in the outstanding non-Final Office Action, it is submitted that claims 1-6, 8-13, and 15-21 and new claim 22 are now in condition for allowance. An early and favorable Notice of Allowance is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, the Examiner is courteously requested to contact Applicants' undersigned representative.

Respectfully submitted,

Reg. No. : 38, 434

By


Eric J. Robinson
Reg. No. 38,285

Signed for Eric Robinson

NIXON PEABODY, LLP
8180 Greensboro Drive, Suite 800
McLean, Virginia 22102
Telephone: (703) 770-9110
Facsimile: (703) 883-0370

VERSION OF AMENDED CLAIM WITH
MARKINGS TO SHOW CHANGES MADE

1. (Amended) A method of transmitting an advertisement from a sending party to a receiving party comprising the steps of:

initiating a communication from a data processing system associated with the sending party;

associating a preselected advertisement with said communication within the data processing system associated with the sending party; and

transmitting said communication with said preselected advertisement embedded therein to the recipient.